

REMARKS

Applicant has considered the April 21, 2006 Office Action, and the amendments above together with the comments that follow are presented in a bona fide effort to address all issues raised in that Action and thereby place this case in condition for allowance. Claims 1-12 are pending in this application. In response to the Office Action dated April 21, 2006, claims 1 and 12 have been amended. Care has been exercised to avoid the introduction of new matter. Adequate descriptive support for the present Amendment should be apparent throughout the originally filed disclosure as, for example, the depicted embodiments and related discussion thereof in the written description of the specification. Applicant submits that the present Amendment does not generate any new matter issue. Entry of the present Amendment is respectfully solicited. It is believed that this response places this case in condition for allowance. Hence, prompt favorable reconsideration of this case is solicited.

Claims 1-3 and 7-12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Applicant's Admitted Prior Art ("AAPA") in view of Harasaki et al. (U.S. Pat. No. 4,392,545, hereinafter "Harasaki"). Applicant respectfully traverses the rejection under 35 U.S.C. § 103(a).

The Examiner admitted that AAPA does not disclose the placement of auxiliary equipment in the space formed by the supporting member and the bracket. The Examiner asserted that it would have been obvious to one of ordinary skill in the art at the time of invention to manufacture the components in the engine compartment in such a way that the components closest to the outer perimeter of the engine compartment are of lesser strength than the components further into the compartment. The Examiner asserted that this structural arrangement enables the crumple zone of the vehicle to form in such a way that the outer structure deforms to

dissipate impact energy while gradually stiffening as the impact propagates towards an occupant/operator. Applicant respectfully traverses and requests reconsideration and withdrawal of the rejection in view of the foregoing amendments to claims 1 and 12 and the following remarks.

In the engine mounting structure of the AAPA (see Fig. 8), a large space 18 needs to be provided between the engine 1 and the engine mount 3 to secure a margin for deformation 17 for the engine bracket 2 (see Fig. 9), in order to prevent the engine 1 from damage when an impact load is applied from the front side of the vehicle, thereby limiting flexibility of arrangement of equipment such as the auxiliary equipment 16 inside the engine compartment. See specification at pages 1-2.

The present invention was made in the light of the above described problem associated with the AAPA. An object of the present invention is to provide a structure for mounting an engine which enhances flexibility of arrangement of equipment inside an engine compartment. See specification at page 2. As described in the present specification, the present invention is directed to a protective mounting structure for an engine of a vehicle in which auxiliary equipment is positively and effectively used for protection of the engine and disposed in a space between the engine and a supporting member supporting the engine. With this arrangement, it is possible to absorb the impact energy sufficiently with the auxiliary equipment 36 disposed in the space 35 between the engine 21 and the engine mount 23. See Figures 1 and 2 of the present specification. In addition, since the auxiliary equipment 36 can be disposed in the space 35 between the engine 21 and the engine mount 23, it is possible to enhance flexibility of arrangement of equipment inside an engine compartment.

Independent Claim 1, as well as independent claim 12, have been amended to clarify that the supporting member (23) supports the engine (E) on a front side thereof in a longitudinal direction of the vehicle (37), and auxiliary equipment (36) is disposed in a space between the front side of the engine and the supporting member. According to the present claimed subject matter, the space between the front side of the engine and the supporting member is effectively used, while minimizing the sacrifice of the zone to be deformed at the beginning stage of the vehicle frontal collision.

In contrast, Harasaki does not teach or suggest the feature of the present claimed subject matter. In Harasaki, a differential gear device (18), which according to the Examiner in the final Office action, corresponds to the auxiliary equipment of the present invention. However, the differential gear device (18) is arranged on the rear side of the engine in the vehicle longitudinal direction. See Fig. 5 of Harasaki. Therefore, space around the differential gear device (18), for example, the space between the differential gear device (18) and the transverse member (5) functions as the deformation zone only when a load to the vehicle is so large in the vehicle frontal collision that the engine moves rearward relative to the vehicle body. The space around the differential gear device on the rear side of the engine has nothing to do with the deformation zone for the beginning stage of the vehicle frontal collision for protecting the engine.

Thus, Applicant submit that Harasaki fails to remedy the Examiner's admitted deficiencies of the AAPA. Moreover, Applicant submits that absent the present specification as a template, one of ordinary skill in the art would not have been realistically motivated to modify the AAPA with Harasaki to dispose auxiliary equipment in the space between the front side of the engine and the supporting member. Rather, the only motivation for such a limitation is Applicant's own disclosure. Applicant's disclosure, however, is forbidden territory for the

Examiner to obtain the requisite motivation for combining the applied prior art. *Panduit Corp. v. Dennison Mfg. Co.*, 774 F.2d 1082, 227 USPQ 337 (Fed. Cir. 1985). Applicant submits that the Examiner has not established a prima facie basis to deny patentability to the claimed subject matter under 35 U.S.C. § 103 for lack of the requisite factual basis and lack of the requisite realistic motivation. *Smiths Industries Medical System v. Vital Signs Inc.*, 183 F.3d 1347, 51 USPQ2d 1415 (Fed. Cir. 1999).

At least for the stated above reasons, independent claims 1 and 12, as amended, are not rendered obvious from the Examiner's combination of the AAPA and Harasaki. Reconsideration and withdrawal of the rejection are solicited.

Dependent claim 4 was rejected under 35 U.S.C. § 103(a) as being unpatentable over AAPA in view of Harasaki and further in view of Park (U.S. Pat. No. 6,386,309, hereinafter "Park"). Applicant respectfully traverses the rejection under 35 U.S.C. § 103(a).

Dependent claims 5-6 were rejected under 35 U.S.C. § 103(a) as being unpatentable over AAPA in view of Harasaki and further in view of Noboru (JP 5-136660, hereinafter "Noboru"). Applicant respectfully traverses the rejection under 35 U.S.C. § 103(a).

Applicant incorporates herein the arguments previously advanced in traversal of the rejection of claims 1-3 and 7-12 under 35 U.S.C. § 103. The tertiary references to Park and Noboru do not cure the argued deficiencies of AAPA and Harasaki. Thus, even if the applied references are combined as suggested by the Examiner, and Applicant does not agree that the requisite realistic motivation has been established, the claimed invention will not result. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988). Reconsideration and withdrawal of the rejections of claims 4-6 are respectfully requested.

It is believed that all pending claims are now in condition for allowance. Applicant therefore respectfully requests an early and favorable reconsideration and allowance of this application. If there are any outstanding issues which might be resolved by an interview or an Examiner's amendment, the Examiner is invited to call Applicant's representative at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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